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In re Application of	:	OFFICE OF PETITIONS
PALANI et al.	:	
Application No. 09/995,949	:	DECISION ON PETITION
Filed: 11/28/2001	:	
Attorney Docket No. CN01365K	:	

This is a decision on the petition filed August 24, 2004, which is being treated as a petition under 37 CFR 1.181 (feeless) to withdraw the holding of abandonment.

The petition is **dismissed**.

On October 6, 2003, the Office mailed a final Office action, which set a three-month shortened statutory period to reply. Petitioner obtained an extension of time for response within the first month pursuant to 37 CFR 1.136(a). Accordingly, the application became abandoned on February 7, 2004. A Notice of Abandonment was mailed on July 27, 2004. On August 24, 2004, petitioner filed the present petition.

Petitioner asserted that he submitted a timely reply to the final Office action in the form of an amendment with a certificate of mailing dated February 6, 2004. Petitioner submitted a copy of the reply and a request for an extension of time, bearing a certificate of mailing date of February 6, 2004, and a copy of the return date-stamped postcard receipt.

Initially, the Office must determine whether the application is, in fact, abandoned. Namely, the Office must review the present petition to evaluate if petitioner's assertions merely involve the cause of the abandonment. Therefore, where there is no dispute as to whether an application is abandoned because no disagreement exists regarding the sufficiency of the reply or controlling dates, the filing of a petition under 37 CFR 1.181(a) to withdraw the holding of abandonment would be inappropriate. See MPEP 711.03(c)(I). Instead, a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application. See MPEP 711.03(c)(I).

The Office notes that the original reply and request for extension of time are in the file. The certificate of mailing of February 6, 2004, renders the reply timely filed. Nevertheless, upon reviewing petitioner's response to the final Office action, the Examiner issued an Advisory Action on June 15, 2004, stating that petitioner's reply failed to place this application in condition for allowance. The Office further notes that a response to a final Office action may be entered if it places the application in condition for allowance. However, the admission or refusal to admit an amendment after a final rejection will not operate to relieve the application from its condition. The entry of an amendment after a final rejection is not a matter of right. It is clear from 37 CFR 1.116 that abandonment of an application is risked when an amendment is filed after a final Office action. Abandonment takes place by operation of law for failure to timely submit a proper reply to an Office action, not by the mailing of an Office communication, such as an Advisory Action.¹ The mere filing of an amendment in response to a final Office action does not save the application from abandonment. Rather, the filing of a Notice of Appeal, a Request for Continued Examination accompanied by a proper submission, or a continuing application in response to a final rejection guarantees the pendency of the application.

The application is currently abandoned due to petitioner's failure to submit a proper response to the final Office action. Under the circumstances of this case, the application did not become abandoned due to a delay in reviewing the amendment or the mailing of the Advisory Action or any other error on the part of the U.S. Patent and Trademark Office. Accordingly, the petition to withdraw the holding of abandonment is **dismissed**.

Petitioner may wish to consider filing a petition under 37 CFR 1.137(b) to revive the application. The provisions of 37 CFR 1.137(b) provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The required reply to the outstanding Office action;
- (2) The petition fee as set forth in 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

With the present petition, petitioner provided the Office with a copy of the amendment submitted on February 11, 2004 (certificate of mailing date of February 6, 2004) as the reply to the outstanding final Office action. However, as the Examiner previously stated in the Advisory Action mailed June 15, 2004, the amendment failed to place the application in condition for allowance. Therefore, the amendment is not a proper reply to the final rejection. Accordingly, petitioner must submit an appropriate reply with any petition under 37 CFR 1.137(b).

In a nonprovisional application abandoned for failure to reply to a final action, the reply required for consideration of a petition to revive must be:

¹ MPEP 711.03(c). See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 299-30 (CCPA 1964); Krahn v. Comm'r, 15 USPQ2d 1823, 1824 (E.D. Va. 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1984).

- (1) A Notice of Appeal and appeal fee;
- (2) An amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise *prima facie* places the application in condition for allowance;
- (3) The filing of an RCE (accompanied by a submission that meets the reply requirements of 37 CFR 1.111 and the requisite fee) under 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995; or
- (4) The filing of a continuing application under 37 CFR 1.53(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Correspondence may also be submitted via the Electronic Filing System of the USPTO.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.



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